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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/517,081

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Stephane Anres

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7590

06/27/2008

COHEN, PONTANI, LIEBERMAN & PAVANE LLP  
551 FIFTH AVENUE  
SUITE 1210  
NEW YORK, NY 10176

EXAMINER

SINGH, SUNIL

ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/517,081	<b>Applicant(s)</b> ANRES ET AL.	
	<b>Examiner</b> Sunil Singh	<b>Art Unit</b> 3672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 25-36 is/are pending in the application.
- 4a) Of the above claim(s) 9-11, 27 and 28 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 25, 26, 29, 30 and 36 is/are allowed.
- 6) ☒ Claim(s) 1-4, 5, 6-8, 12-15, 31-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-4,5-8,12-15,31-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claims 1-4,5-8,12-15,31-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The above mentioned claims are ambiguously constructed and indeterminate in scope because the purport to claim both a product/apparatus and method of using or practicing the product/apparatus in a single claim.

### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-4, 5,6-8,12-15, ,31,32,33,34,35 are rejected under 35 U.S.C. 101 because they improperly embrace both product or machine and process. The language of 35 USC 101 sets forth statutory classes of invention in alternative only. See *Ex parte Lyell*, 17 USPQ2d 1549.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Gonzalez (US 5184686).

Gonzalez discloses a drilling installation comprising a guide device comprising pre-assembled (this is the case since the guide device is assembled before production) coaxial telescopic (this is the case since 22b moves relative to 22a and 22c moves relative to 22a and 22b) guide elements (22a,b,c), a drilling riser (20), a drill string (28) with a drilling tool(38), outer guide element (22a), inner guide element (22c), breakup means (see Figs. 10-13, see Fig. 7, at the port where arrow 44 is pointing for better illustration of the breakup means). Breakup means comprises perforated capsule (see col. 4 lines 10-15).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 5,31,32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gonzalez.

Gonzalez discloses the invention substantially as claimed. However, Gonzalez is silent about the lengths of the guide elements. The examiner takes official notice that having guide elements of varying lengths is old and well known. It would have been considered obvious to one of ordinary skill in the art to modify Gonzalez to have guide elements with the lengths called for in claims 5,31,32 since such choice would be a design choice. Depending on the particular depth one intends to drill, the particular lengths would then dictate.

10. Claims 6-8, 12-13, 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gonzalez in view of Hale et al. or Shiroyama et al. or Johnson et al. (US 3333432, 3824798, 4812079) or Japanese document (53-118791) or Wipo document (EP 0952301)

Gonzalez discloses the invention substantially as claimed. However, Gonzalez is silent about the guide device including a front end configured to rest horizontally on the sea bottom, a curved intermediate portion buried in the subsoil, a rear portion that is substantially linear and buried in the subsoil. Hale et al., Shiroyama et al., Johnson et al., Japanese document and Wipo document all disclose a guide device a front end resting substantially horizontally on the seabed (this is the case in as much applicant Figures 16-19 meet this limitation), a curved intermediate portion and a substantially linear rear portion (see Figures of the above mentioned references). It would have been

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considered obvious to one of ordinary skill in the art to modify Gonzalez to include a guide device as taught by either Hale et al. or Shiroyama et al. or Johnson et al. or Japanese document or Wipo document (EP 0952301) since such a modification enhances lateral boring.

With regards to the "radius of curvature", "angle of inclination" and "guide pipe length" limitations, it would have been considered obvious to modify Gonzalez to include such limitations as called for in the above claims since such modifications are design choices. Depending on the particular depth, specific location etc. the above modifications would be appropriate.

### ***Allowable Subject Matter***

11. Claims 25-26, 29-30,36 are allowed.

### ***Response to Arguments***

**12.** Applicant's arguments filed 3/17/08 have been fully considered but they are not persuasive. Applicant argues that Gonzalez does not teach telescoping guide elements, instead they are simply slidable with respect to one another. It should be noted that the definition of telescoping is slide or pass one within another which is exactly what Gonzalez teaches. This is the case since 22b moves relative to (pass within) 22a and 22c moves relative (pass within) to 22a and 22b. Applicant argues that Gonzalez fails to teach "wherein said pre-assembled coaxial telescopic guide elements are pre-assembled together before said extension from said retracted position to said deployed

position thereby enabling the cementing of said guide pipe only after said guide pipe has been fully deployed". Applicant should note that claim 1 is directed to a product/apparatus having a riser, drill string with a tool, a guide device with at least outer, intermediate and inner guide elements. Gonzalez teaches such limitations. It appears that applicant is relying on the method of using/installing the product/apparatus. Please note claim 1 is directed to a product/apparatus and not a method of using/installing. Pre-assembled is defined as assembled beforehand. Therefore, Gonzalez teaches "pre-assembled" since the guide device is assembled before production.

### ***Conclusion***

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sunil Singh whose telephone number is (571) 272-7051. The examiner can normally be reached on Monday through Friday 10:30 AM - 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on (571) 272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sunil Singh/  
Primary Examiner, Art Unit 3672

Sunil Singh  
Primary Examiner  
Art Unit 3672

SS

6/18/08